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EXAMINER

AKINTOLA, OLABODE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/887,629
Filing Date: June 22, 2001
Appellant(s): BANSAL ET AL.

Peter Balnave
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 20, 2009 appealing from the Office action mailed November 25, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20020016760

Pathak, Sanjesh

02-2002

Tannenbaum, J., "Web Sites Help Small Companies Open Internet Stores--E-Business Service

Art Unit: 3691

Providers Offer Inexpensive Way to Try Something New", Wall Street Journal, New York, N.Y.:

April 25, 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pathak (US 20020016760)

("Pathak") in view of Tannenbaum, J ("Web Sites Help Small Companies Open Internet Stores--

Art Unit: 3691

E-Business Service Providers Offer Inexpensive Way to Try Something New", Wall Street Journal, New York, N.Y.: April 25, 2000) (hereinafter referred to as "Tannenbaum").

Re claims 1, 19 and 37: Pathak teaches a method for enabling the online determination of end to end costs during an online ascending or reverse auction, said method comprising: maintaining an online database of costs associated with each significant cost element in order to compute said end to end costs for goods and services offered by an offerer and bid upon by a bidder (sections 033); receiving a first online bid to buy or sell said offered goods and services from a first bidder (sections 033); updating said online database of costs related to said first online bid and calculating a first bid's end to end costs related to said first online bid (sections 033); receiving a second online bid to buy or sell said offered goods and services from a second bidder (sections 033); updating said online database of costs related to said second online bid and calculating a second bid's end to end costs related to said second online bid (sections 033); if, in an ascending auction, said second bid's end to end costs result in a higher payout to said offerer than the first bid's end to end costs, then accepting said second bid, else accepting said first bid (section 0009, 0010, 0014, claim 3 (f.iv-f.v and d.)); and if, in a reverse auction, said second bid's end to end costs result in a higher cost to said offerer than the first bid's end to end costs, then accepting said first bid, else accepting said second bid (section 0009, 0010, 0014, claim 6 (f.iv-f.v and d)).

Pathak does not explicitly teach the method is implemented by an online intermediary providing facilities as a service free of charge. Tannenbaum teaches an online intermediary (entity hosting) providing facilities as a service free of charge (pages 1-2). It would have been obvious to one

Art Unit: 3691

ordinary skill in the art at the time of the invention to modify Pathak to have an intermediary provide this service for free in exchange for placing advertisement on the website.

Re claims 3, 21 and 39: Pathak teaches wherein said each significant cost element includes any of shipping and handling costs, logistics management costs, taxes, finance costs, commissions, duties, insurance, regulatory and statutory-related costs, and information costs (section 0033).

Re claims 4, 22 and 40: Pathak teaches wherein databases, which provide information for updating said online database of costs, are associated with said offerer, said bidder or by a third party (section 0033, fig. 1).

Re claims 8-9, 13-14, 26-27, 31-32, 44-45 and 49-50: Pathak teaches an online ascending and reverse auctions; minimum/maximum qualifying bid (abstract, sections 0009, 0010, 0014, 0033, claim 3 (f.iv-f.v and d.), claim 6 (f.iv-f.v and d)).

Re claims 15, 33 and 51: Pathak teaches wherein updated offers are shown to potential bidders after online computation of said end to end cost (section 0013)

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

Art Unit: 3691

A. Rejection of claims 1, 3-4, 8-9, 13-15, 19, 21-22, 26-27, 31-33, 37, 39-40, 44-45 and 49-51 under 35 U.S.C. § 103(a) as being unpatentable over Pathak in view of Tannenbaum.

1. Regarding independent claims 1 and 37, Appellant asserts that Pathak does not disclose entering any other information like shipping and handling cost, etc. to calculate a first and second bids' end-to-end costs related to the first and second online bids respectively (Appeal Brief, pages 11 and 12)

In Response: Examiner respectfully disagrees with Appellant's assertion. Pathak explicitly teaches an optimization program 105 (section 0033), that takes into account the bid amount and additional information such as shipping, tax and handling to calculate the winning bid(s) (claim 3 (f.iv-f.v and d.)).

For these reasons, Examiner respectfully submits that Pathak and Tannenbaum combination renders the subject matter of claims 1 and 37 obvious.

2. Regarding claims 3 and 39, Appellant asserts that Pathak fails to teach "logistic management cost, finance cost, commission, duties, insurance, regulatory and statutory related costs and information costs (Appeal Brief, page 15).

Art Unit: 3691

In Response: Examiner respectfully disagrees with Appellant's assertion. These costs as recited in these claims are considered as other costs that are related to the trade ((claim 3 (f.iv-f.v and d.)).

3. Regarding claims 4 and 40, Appellant asserts that Pathak does not disclose updating an online database for a “third party” (Appeal Brief, page 15).

In Response: Examiner respectfully disagrees with Appellant's assertion. The claims limitation “said offerer, said bidder, or by a third party” is in the alternative. The databases are associated with an offerer (seller) or a bidder (seller) (section 0033).

4. Regarding claims 8-9 and 44-45, Appellant asserts that Pathak does not disclose an ascending or reverse auction between an offerer and at least two bidder (Appeal Brief, page 16).

In Response: Examiner respectfully disagrees with Appellant's assertion. Pathak teaches both forward and reverse auction between an offerer and at least two bidder (abstract, sections 0009, 0010, 0014, 0033, claim 3 (f.iv-f.v and d.), claim 6 (f.iv-f.v and d)).

5. Regarding claims 13-14 and 49-50, Appellant asserts that Pathak does not disclose wherein information regarding a qualifying bid is sent to a potential bidder (Appeal Brief, page 16).

Art Unit: 3691

In Response: Examiner respectfully disagrees with Appellant's assertion. Pathak teaches buyer or seller specifies a reserve price (section 0014).

5. Regarding claims 15 and 51, Appellant argument is similar to that of claim 1 (Appeal Brief, page 16 [0019-0020]) .

In Response: Similar rationale for rejection of claim 1 is hereby maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Olabode Akintola /O. A./
Examiner, Art Unit 3691
29 August 2007

Conferees:
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